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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,519

01/08/2004

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EXAMINER

CARDENAS NAVIA, JAIME F

ART UNIT

PAPER NUMBER

3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/753,519	Applicant(s) GRIMM ET AL.	
	Examiner Jaime Cardenas-Navia	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. This **NON-FINAL** office action is in response to applicant's submission filed on January 8, 2004. Currently, claims 1-22 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-22 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 5, 7, 11, 13, and 19, "similar" is relative term, which renders the claim indefinite. For purposes of examination, every instance of "similar resource" has been interpreted as "the same type of resource". For example, claim 1, lines 8-12 are interpreted as follows:

...capacity manager determining when a selected type of one of the plurality of resources is required, and when the selected type of resource is required, the capacity manager determining whether unused billed capacity for the same type of resource is available, and if so, the capacity manager assigning the unused billed capacity for the same type of resource to the selected resource.

Examiner believes this modification to claim language removes indefinite language and is more consistent with the specification, in which the "selected resource" (additional processor) is the same type of resource as the "similar resource" (processor already billed for).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 13-22 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A “program product” does not fall into one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). Software, programming, instructions or code not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program’s functionality to be realized, the program will be statutory.

For purposes of examination, the claims have been interpreted as a properly claimed computer program product.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-22 are rejected** under 35 U.S.C. 102(b) as being anticipated by Wyman (US 5,745,879).

Regarding claim 1, Wyman teaches an apparatus comprising:

at least one processor (col. 6, lines 36-38);

a memory coupled to the at least one processor (col. 6, lines 24-30, database is memory);

a plurality of resources coupled to the at least one processor that provides temporary capacity on demand (col. 6, lines 27-30, product use authorizations (software licenses) are plurality of resources); and

a capacity manager residing in the memory and executed by the at least one processor, the capacity manager managing access to the plurality of resources, the capacity manager determining when a selected one of the plurality of resources is required, and when the selected resource is required (col. 6, lines 24-38), the capacity manager determining whether unused billed capacity for the same type of resource is available, and if so, the capacity manager assigning the unused billed capacity for the same type of resource to the selected resource (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource).

Regarding claim 2, Wyman teaches wherein the capacity manager bills a predetermined resource-time for the selected resource if no unused paid capacity for the same type of resource is available (col. 14, lines 31-42, if there are no more units available, then the license holder is required to pay for the additional use).

Regarding claim 3, Wyman teaches wherein the capacity manager deducts the billed predetermined resource-time from a prepaid amount (col. 14, lines 20-42, units are a prepaid amount, the billed predetermined resource-time is deducted from this).

Regarding claim 4, Wyman teaches wherein the capacity manager further determines whether the selected resource has already been billed (col. 12, lines 45-49, col. 14, lines 30-42, units, which have already been billed, are tracked, and accounting for all resource use is tracked and managed by the license manager for billing purposes).

Regarding claim 5, Wyman teaches an apparatus comprising:

- at least one processor (col. 6, lines 36-38);
- a memory coupled to the at least one processor (col. 6, lines 24-30, database is memory);
- a plurality of logical partitions defined on the apparatus (Fig. 1, many logical partitions);
- at least one resource that provides temporary capacity on demand (col. 6, lines 27-30, product use authorizations (software licenses) are at least one resource); and
- a capacity manager residing in the memory and executed by the at least one processor, the capacity manager managing access to a selected resource (col. 8, lines 22-27), the capacity manager performing the steps of:
 - determining when the selected resource is required (col. 6, lines 24-38);

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determining whether the selected resource has already been billed (col. 12, lines 45-49, col. 14, lines 30-42, units, which have already been billed, are tracked, and accounting for all resource use is tracked and managed by the license manager for billing purposes);

if the selected resource has not already been billed, determining whether unused billed capacity for the same type of resource is available (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource);

if unused billed capacity for the same type of resource is available, assigning the unused billed capacity of the same type of resource to the selected resource (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource); and

if unused billed capacity for the same type of resource is not available, billing a predetermined resource-time for the selected resource (col. 14, lines 31-42, if there are no more units available, then the license holder is required to pay for the additional use).

Regarding claim 6, Wyman teaches wherein the capacity manager deducts the billed predetermined resource-time from a prepaid amount (col. 14, lines 20-42, units are a prepaid amount, the billed predetermined resource-time is deducted from this).

Regarding claims 7-12, they are rejected using the same art and rationale used above for rejecting claims 1-6. This is because claims 7-12 claim a computer-implemented method for performing the steps of the apparatus of claims 1-6.

Regarding claim 13, Wyman teaches a program product comprising:

a capacity manager that manages access to a plurality of computer system resources (col. 8, lines 22-27), the capacity manager determining when a selected one of the plurality of resources is required, and when the selected resource is required (col. 6, lines 24-38), the

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capacity manager determining whether unused billed capacity for the same type of resource is available, and if so, the capacity manager assigning the unused billed capacity of the same type of resource to the selected resource (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource); and

computer readable signal bearing media bearing the capacity manager (col. 8, lines 22-38).

Regarding claim 14, Wyman teaches wherein the signal bearing media comprises recordable media (col. 8, lines 22-38).

Regarding claim 15, Wyman teaches wherein the signal bearing media comprises transmission media (col. 8, lines 22-38).

Regarding claim 16, Wyman teaches wherein the capacity manager bills a predetermined resource-time for the selected resource if there is no unused paid capacity for a same type of resource available (col. 14, lines 31-42, if there are no more units available, then the license holder is required to pay for the additional use).

Regarding claim 17, Wyman teaches wherein the capacity manager deducts the billed predetermined resource-time from a prepaid amount (col. 14, lines 20-42, units are a prepaid amount, the billed predetermined resource-time is deducted from this).

Regarding claim 18, Wyman teaches wherein the capacity manager further determines whether the selected resource has already been billed (col. 12, lines 45-49, col. 14, lines 30-42, units, which have already been billed, are tracked, and accounting for all resource use is tracked and managed by the license manager for billing purposes).

Regarding claim 19, Wyman teaches a program product comprising:

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(A) a capacity manager managing access to a selected computer system resource (col. 6, lines 24-38), the capacity manager performing the steps of:

determining when the selected resource is required (col. 6, lines 24-38);

determining whether the selected resource has already been billed (col. 12, lines 45-49, col. 14, lines 30-42, units, which have already been billed, are tracked, and accounting for all resource use is tracked and managed by the license manager for billing purposes);

if the selected resource has not already been billed, determining whether unused billed capacity for a similar resource is available (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource);

if unused billed capacity for a similar resource is available, assigning the unused billed capacity of the similar resource to the selected resource (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource); and

if unused billed capacity for a similar resource is not available, billing a predetermined resource-time for the selected resource (col. 14, lines 31-42, if there are no more units available, then the license holder is required to pay for the additional use); and

(B) computer readable signal bearing media bearing the capacity manager (col. 8, lines 22-38).

Regarding claim 20, Wyman teaches wherein the signal bearing media comprises recordable media (col. 8, lines 22-38).

Regarding claim 21, Wyman teaches wherein the signal bearing media comprises transmission media (col. 8, lines 22-38).

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Regarding claim 22, Wyman teaches wherein the capacity manager deducts the billed predetermined resource-time from a prepaid amount (col. 14, lines 20-42, units are a prepaid amount, the billed predetermined resource-time is deducted from this).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ginter et al. (US 5,949,876) teaches deducting tokens or electronic currency from an account used to purchase computer resources.

Bains et al. (US 5,579,222) teaches checking for additional available resources that are idle that can be used.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime Cardenas-Navia whose telephone number is (571)270-1525. The examiner can normally be reached on Mon-Thur, 9:30AM - 8:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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April 17, 2008

/J. C./
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623